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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/870,199	06/05/97	WEBB	1814

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FAY, Z EXAMINER

ART UNIT	PAPER NUMBER
1814	

11/09/01 22

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/870,199

Applicant(s)

Webb

Examiner

Zohreh Fay

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1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above, claim(s) 31-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☒ Interview Summary (PTO-413) Paper No(s). 16
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Claims 1-56 are presented for examination.

The above case for the following reason is withdrawn from issue.

Claims 1-30 are rejected under 35 U.S.C. 103 as being unpatentable over Hazariwala et al. And Fechner.

Hazariwala et al. Teach the use of 2% hydroxypropylmethyl cellulose as a safe viscoelastic material used during cataract surgery. See the entire document. Fechner teaches a process for preparing the 2% hydroxypropylmethyl cellulose of dissolving, filtering and autoclaving. See the entire document.

One skilled in the art would have been motivated to combine the teachings of the above references, since they in combination relate to a safe composition of hydroxypropylmethyl cellulose in ophthalmic surgery and also a process for preparing such composition. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 1-30 are properly rejected under 35 U.S.C. 103.

The instant application should be withdrawn from issue for the following reasons.

The original claims are both narrowed and broadened. There is no problem with narrowing the claims. However, there is a problem with broadening the claims in that it removes the limitation that was relied on for the allowance of the parent application and thus can not be removed. (See MPEP 1412.02) specifically removing the limitation “(cellulose solution free of particulate matter and gels) (greater than 0.5 um in diameter)...” is impermissible. (Note inserting “harmful” before particulate narrows the claims with respect to the type of particulate

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matter permitted, but has no limitation as to particle size.) As now drafted both composition and method claims have no limitation on particle size of non-harmful particles. The prosecution in the parent application shows that applicant argued that 0.5  $\mu\text{m}$  in diameter maximum particle size defined over the prior art. The examiner accepted this as a defining limitation based on at least one of the affidavits submitted to obtain allowance of the claims. To allow removal of this limitation would allow recapture of subject matter excluded by applicant's argument leading to allowance of the claims.

Furthermore, claim 13 is incorrectly amended in amendment B1 as is added claim 27. In addition, newly claims 31-56 (amendment C1) are improper as presented as they must be entirely underlined. To present them in a single column format, as done in the instant application, is not proper. See 37 CFR 1.173(d) and MPEP 1453 for proper amendment presentation. These claims must be presented in proper form in new amendment. Additionally, a supplemental declaration is required for any amendments made during the prosecution. See MPEP 1414.01.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Fay whose telephone number is (703) 308-4604.

ZOHREN FAY  
PRIMARY EXAMINER  
GROUP 1200

